

REMARKS

Claims 4 and 6-8 have been canceled. Claims 1-3, 5, and 9-12 remain pending in the application. Applicant amends claims 1, 9, and 11 for further clarification, and refers to Fig. 4 and its corresponding description—including page 6, line 25 to page 7, line 7—in the specification for an exemplary embodiment of and support for the claimed invention. No new matter has been added.

Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,377,795 to Bach et al. in view of U.S. Patent Application Publication No. 2002/01114431 to McBride et al., and further in view of U.S. Patent No. 5,065,427 to Godbole; claims 1-2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bach et al. in view of McBride et al., Godbole, and further in view of U.S. Patent No. 5,206,900 to Callele; and claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bach et al., Callele, McBride et al., Godbole, and further in view of U.S. Patent No. 6,026,152 to Cannon et al. Applicant amends claims 1, 9, and 11 in a good faith effort to further clarify the invention as distinguished from the cited references, and respectfully traverses the rejections.

The Examiner relied upon description in Bach et al. of a user preprogramming acceptance of certain calls as alleged disclosure of the claimed calling tone issuing feature when the originating number is registered. The Examiner acknowledged that Bach et al. fail to disclose the claimed “immediately connecting” features, and relied upon McBride et al. as a combining reference that allegedly suggests these features.

But as illustrated by steps 246, 218, 219, and 220 in Fig. 10—and as described in the corresponding description—of McBride et al., the technique described therein, as cited and relied upon by the Examiner, only includes description of playing a greeting—either “canned” (step 217) or “custom” (step 246)—and receiving a “passcode” before issuing a

“ring signal” (220) for all calls, whether they are “registered” with a custom greeting or not.

Thus, Bach et al., as cited and relied upon by the Examiner, only describe issuing one or more rings before either connecting or going to an auto accept routine for all non-rejected calls, and McBride et al., as cited and relied upon by the Examiner, only describe playing a greeting—either “canned” or “custom”—before generating a ring signal for all calls. And both references, at most, suggest “dumping” (Fig. 10 of McBride et al.) or “rejecting” (Fig. 3 of Bach et al.) a non-registered call before it is accepted or issued a ring. In other words, neither reference includes any disclosure or suggestion of different call connecting procedures in relation to generating a ring signal between “registered” and “unregistered” calls. Indeed, both references teach away from connecting a non-registered call more quickly in relation to a ring signal than a registered call.

The Examiner relied upon Godbole as a further combining reference to specifically address the claimed calling time monitoring features. Again, the cited portions of Godbole only describe setting a limit timer between receiving an incoming call and outputting an “answertone” for answering the incoming call according to type within the time limit. Please see, e.g., Fig. 2A of Godbole. The Examiner apparently relied upon the description of the “answertone” in Godbole as alleged suggestion of the claimed calling tone—and correspondingly, the description in Godbole of setting a five second timer limit between receiving an incoming call and issuing the “answertone” as alleged suggestion of the claimed calling time monitoring features. The cited portions of Godbole only include, however, description of setting a time limit between going “off hook” for—i.e., receiving or “connecting”—an incoming call, and outputting an “answertone” back to a caller according to call type—e.g., “fax,” “data modem,” or “DTMF digit.” And Godbole, as cited and relied upon by the Examiner, does not disclose or suggest ever issuing such an “answertone” before an incoming call is received and connected. In other words, Godbole, as cited and relied

upon by the Examiner, teaches away from issuing a calling tone before connecting a call while monitoring a calling time between the arrival of the call and an issuance of such a calling tone. Furthermore, the “answertone” described in Godbole is incongruous with the ring signal described in McBride et al., also relied upon by the Examiner as disclosure of the claimed calling tone.

Applicant, thus, respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in failing to provide any motivation, suggestion, or objective reason, other than improper hindsight from the claimed invention itself, to alter and combine the cited references to meet the claimed invention in contradiction to the explicit disclosures of Bach et al., McBride et al., and Godbole, respectively.

And even assuming, arguendo, that it would have been obvious to one skilled in the art at the time the claimed invention was made to combine Bach et al., McBride et al., and Godbole, such a combination would still have failed to disclose or suggest,

“[a] method for preventing one-time only calls to a portable telephone set, comprising:
retrieving data from a telephone directory database if a call arrives at a portable terminal device, and determining whether an originating number is registered in the telephone directory database;
monitoring a calling time between the arrival of the call and an issuance of a calling tone;
immediately connecting the call before the issuance of the calling tone when the originating number is not registered in the telephone directory database, and announcing a prearranged recorded message; and
issuing one or more of the calling tone before connecting the call when the originating number is registered as a predetermined type of originator in the telephone directory database, wherein
a recorded message response time between the arrival of the call and the announcement of a recorded message is stored for each name registered in the telephone directory database, and
an incoming recorded message response time is set for an incoming call by referring to the stored recorded message response time corresponding to the originating number when

the originating number is registered in the telephone directory database,” as recited in claim 9. (Emphasis added)

Accordingly, Applicant respectfully submits that claim 9, together with claim 10 dependent therefrom, is patentable over Bach et al., McBride et al., and Godbole, separately and in combination, for at least the foregoing reasons. Claim 11 incorporates features that correspond to those of claim 9 cited above, and is, therefore, together with claim 12 dependent therefrom, patentable over the cited references for at least the same reasons. The Examiner cited Callele as a further combining reference to specifically address the additional features recited in claim 1, which also incorporates features that correspond to those of claim 9 cited above. As such, a further combination with Callele would still have failed to cure the above-described deficiencies of Bach et al., McBride et al., and Godbole, even assuming, arguendo, that such a further combination would have been obvious to one skilled in the art at the time the claimed invention was made. Accordingly, Applicant respectfully submits that claim 1, together with claims 2 and 5 dependent therefrom, is patentable over the cited references for at least the foregoing reasons. The Examiner cited Cannon et al. as a further combining reference to specifically address the additional features recited in claim 3, which depends from claim 1. As such, a further combination with Cannon et al. would still have failed to cure the above-described deficiencies of Bach et al., McBride et al., Godbole, and Callele, even assuming, arguendo, that such a further combination would have been obvious to one skilled in the art at the time the claimed invention was made. Accordingly, Applicant respectfully submits that claim 3, which depends from claim 1, is patentable over the cited references for at least the foregoing reasons.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully

requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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